

Reply to the Office Action of March 24, 2005
Response Dated July 20, 2005

Attorney Docket No.: CSCO-005/2899
Appl. No.: 09/910,937

REMARKS

Claims 1-44 were presented for consideration in the application as originally filed. All the claims were rejected under 35 U.S.C. § 103 (a) as being unpatentable over US Patent Number 6,704,317 issued to Dobson in view of United States Patent Application 20010039593 naming 5 as inventor Hariu (hereafter "Hariu"), and United States Patent Number 6,608,830 issued to Hirano *et al* (Hirano).

Applicants swears behind Hariu as provided under 37 CFR § 1.131 entitled "Affidavit or Declaration of prior invention" by submitting a declaration (hereafter "declaration") according to the procedure further outlined in 37 CFR § 131(b) and MPEP § 715. As noted there, one of 1 0 the ways to swear behind requires a showing:

- (A) conception of the invention prior to the effective date of the reference
- (B) coupled with due diligence from prior to the reference date to the filing date of the application (constructive reduction to practice).

The above two requirements are believed to be satisfied by the attached declarations and 1 5 exhibits, further in view of the below remarks.

Declaration by Fewer than All Inventors

It is pointed out that the declaration offered to prove conception and reduction to practice prior to the reference date of April 26, 2001(explained below), is signed only by one inventor 2 0 Mr. Amit Phadnis, but not by the remaining joint inventors Praneet BACHHETI and Anuradha KARUPPIAH.

As noted in MPEP § 715.04.I (entitled, "WHO MAY MAKE AFFIDAVIT OR DECLARATION"), "..., where it is shown that a joint inventor ... is otherwise unavailable, the signatures of the remaining joint inventors are sufficient."

MPEP § 409.03(d) provides additional guidance on establishing how an inventor cannot 2 5 be reached as a basis for the unavailability requirement.

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Points 12-16 of the attached affidavit by the undersigned representative (Narendra Thappeta) clearly establishes that inventors Praneet BACHHETI and Anuradha KARUPPIAH cannot be reached (and thus are unavailable to sign), and accordingly it is respectfully requested that the declaration under 37 CFR § 131 signed only by the available inventor (Mr. Amit Phadnis) be accepted to swear behind the reference.

In the alternative, it is respectfully requested that the attached affidavit by the undersigned representative (Narendra Thappeta) be accepted for the purpose of the necessary showing.

Reference Date to Overcome

1 0 It is noted that Hariu has a filing date of April 26, 2001 with the US Patent Office and is shown with foreign application data as below:

Apr 27, 2000 JP 127564/00
Jun 14, 2000 JP 178076/00

As noted in MPEP § 715.III.A (entitled, "Reference Date to be Overcome:: U.S. Patents, 1 5 U.S. Patent Application Publications, and International Application Publications"):

2 0 The effective date of a domestic patent when used as a reference is not the foreign filing date to which the application for patent may have been entitled under 35 U.S.C. 119(a) during examination. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). Therefore, the date to be overcome under 37 CFR 1.131 is the effective U.S. filing date, not the foreign priority date.

Accordingly, the reference date to be overcome is believed to be the US filing date of April 26, 2001 (and not the earlier filed foreign applications, noted above).

Conception

2 5 The enclosed affidavit signed by Mr. Amit Phadnis, along with the supporting Exhibits, establishes the conception of the invention of at least claim 1 prior to the reference date to be overcome. In particular points 2-6 of the affidavit of Mr. Amit Phadnis establish that the invention of at least claim 1 was clearly conceived by the inventor prior to the reference date.

In the alternative or in addition, points 1-3 of the affidavit by the Undersigned

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Representative, establish the date of conception of at least claims 1 and 2 prior to the reference date to be overcome. As a basis for assertion, it is noted that the MPEP § 715.07.I (entitled, "Facts and Documentary Evidence [R-2]: General Requirements" appears to permit reliance on "F. Attached supporting statements of witnesses, where verbal disclosures are the evidence relied upon..."

Diligence

The enclosed affidavits of Mr. Amit Phadnis and the undersigned representative (Narendra Thappeta) establish diligence from prior to the reference date to the filing date of the application (constructive reduction to practice). The delays between the events noted there are believed to be adequately explained by points 6-8 of the affidavit submitted by the undersigned Representative.

Conclusion

Accordingly, it is respectfully asserted that the Hariu reference is not effective prior art under 35 U.S.C. §§ 102(e) and 103 as against the subject patent application. Withdrawal of the outstanding rejections under 35 U.S.C. § 103 is respectfully requested.

Thus, all the objections and rejections are believed to be overcome and all the presented claims are in condition for allowance over the art of record. The Examiner is invited to telephone the undersigned representative if it is believed that an interview might be useful for any reason.

Respectfully submitted,

Noren Thappet

Date: July 20, 2005

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